

R E M A R K S

1. Claims 1-70 and 119-123 are pending in this Application. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the discussion that follows.

Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §112, first paragraph. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §101. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,263,314 to Donner. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,393,406 to Eder. Claims 42, 45-46, 58-59 and 64-66 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner, Eder and U.S. Pat. No. 5,136,646 to Haber et al. Claims 2, 40 and 41 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner and Eder. Claims 119, 120, 122 and 123 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 6,36,909 to Spencer in view of U.S. Pat. No. 6,556,992 to Barney. After a careful review of the claims (as amended), it has been concluded that the rejections are improper and should be withdrawn.

2. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §112, first paragraph. The Examiner asserts that "A user interface alone cannot characterize whether a trade secret is negative know how" (Office Action of 4/4/06, page 2).

It may be noted in this regard that the dictionary defines "characterize" as "to describe the character or quality of". A user interface is for both displaying and entering

information. The user interface of the claimed system provides the means for describing the character of a trade secret as constituting negative know-how.

The Examiner asserts (Office Action of 4/4/06, page 2) that claims 1-70 and 119-123 fail to comply with the enablement requirements. However, it may be noted in this regard that the means for providing the predetermined criteria for evaluating is the user interface, which is used to provide to the user the predetermined criteria which the user is to apply in making the evaluative judgment. The evaluative judgment is itself outside the scope of the claimed invention.

The claims of the application are directed to the broad concepts described in the specification and include all contexts which perform the specified claim steps regardless of the specific calculations used. The applicant has in fact provided two formulas for the weighting of the six factors by reference -- the arithmetic mean and the geometric mean, both well-defined in the mathematical arts and for which unambiguous formulas are defined.

The Examiner asserts that the answers to the questionnaire are subjective because each user could provide a different answer (Office Action of 4/4/06, page 4). However, the result of the use of the invention for any given set of evaluative judgments is determinate and specific. The evaluative judgments themselves are outside the scope of the claimed invention. The output of the invention is a ranked list that is an aggregation of the user-provided evaluative judgments. The ranked list is an aggregation of the user's own judgments and certainly has utility for the user himself. Examiner's requirement that the output of the invention have utility to someone other than the user is without statutory foundation.

The Examiner asserts (Office Action of 4/4/06, page 5)

that the claimed invention does not have a specific utility. However, the numerical score is an intermediate value in most of the rejected claims, and not an output of the system in any of the rejected claims. As such, questions as to how one would use the numerical score and the definition of the numerical score are not germane. The applicants claim all contexts which perform the specified claim steps regardless of how the numerical score is defined. Examples of possible definitions of the numerical score, the arithmetic mean and the geometric mean, are provided in the specification as required.

In claims 119, 121, 123, one of the claim elements includes a comparison of the calculated numerical score to a predetermined threshold value. These threshold values may be predetermined by the user or by the organization providing the system -- i.e., the applicants or their licensees.

Claim 120 has been rejected as being indefinite. In response, claim 120 has been amended to eliminate any indefiniteness.

Since the description does, in fact, comply with the enablement requirement and does have a specific utility, the rejections under 35 U.S.C. §112, second paragraph are improper. Since the rejections are improper, they should be withdrawn.

3. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §101. In particular, the Examiner asserts (Office Action of 4/4/06, page 6) that the answers to the questionnaire are subjective. Examiner then concludes that the output of the system is not concrete since it would be difficult for a person to repeat the analysis and determination of another.

The invention provides a ranked listing that is an aggregation of the judgment of the user. The evaluative judgments themselves are outside the scope of the invention. For

a given set of evaluative judgments input to the invention, the output of the invention is determinate and well-defined.

The credible asserted utility of the invention is the aggregation of the user's judgment into a ranked listing of trade secrets. The numerical score value in itself is not an output of the invention, and no credible asserted utility for it is required by statute. The utility of the ranked listing of the user's evaluative judgments need only be of value to the user himself and not to some third party hypothesized by the Examiner.

The Examiner asserts that "The means for performing the function . . . in the claims [8-31, 49-56 and 69] appears to be a person" (Office Action of 4/4/06, page 8). In this regard, the rejected claims all specify that the means for performing these functions are part of a programmed computer. Examiner's assertion that "the means for performing the function in the above-referenced claims appears to be a person" is completely outside the claim language.

Since the claims are, in fact, directed to a useful, concrete and tangible results performed by a computer, the rejections are improper. Since the rejections are improper, they should be withdrawn.

4. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected as being anticipated by Donner. The Examiner cites in re Schreiber as a basis for rejecting the claims under Donner. However, the board in rejecting Schreiber found that the structure of Harz was inherently capable of dispensing popcorn. The structure of Donner is not inherently capable of aggregating user judgments related to trade secrets into a ranked listing because it does not disclose a questionnaire based on the six factors of a trade secret.

The Examiner's argument is clearly based upon ignoring the claim limitations requiring that the questionnaire be directed to the six factors of a trade secret. As clearly demonstrated by the case law, the claimed questionnaire is structurally related to the creation of a ranked listing of trade secrets.

Since Donner is not inherently capable of aggregating user judgments related to trade secrets and does not provide any means for ranking potential trade secrets, Donner does not do exactly the same thing in exactly the same way as that of the claimed invention. Since Donner does not do the same or any similar thing as that of the claimed invention, the rejections are improper and should be withdrawn.

5. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected as being anticipated by Eder. The Examiner cites in re Schreiber as a basis for rejecting the claims under Elder.

The board in rejecting Schreiber found that the structure of Harz is inherently capable of dispensing popcorn. The structure of Elder is not inherently capable of aggregating user judgments related to trade secrets into a ranked listing because it does not disclose a questionnaire based on the six factors of a trade secret.

The Examiner's argument is clearly based upon ignoring the claim limitations requiring that the questionnaire be directed to the six factors of a trade secret. As clearly demonstrated by the case law, the claimed questionnaire is structurally related to the creation of a ranked listing of trade secrets.

Since Elder is not inherently capable of aggregating user judgments related to trade secrets and does not provide any means for ranking potential trade secrets, Elder does not do the same or any similar thing in as that of the claimed invention.

Since Eder does not do the same or any similar thing as that of the claimed invention, the rejections are improper and should be withdrawn.

6. Claims 42, 45-46, 58-59 and 64-66 have been rejected as being obvious over Donner, Eder and Haber et al. However, Haber et al. (as with Donner and Eder) also fails to provide any teaching or suggestion of any apparatus for ranking trade secrets.

Since the combination of Donner, Eder and Haber et al. is not inherently capable of aggregating user judgments related to trade secrets or ranking potential trade secrets, the combination fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

7. Claims 2, 40 and 41 have been rejected as being obvious over Donner and Eder. However, as demonstrated above, Donner and Eder fails to provide any teaching or suggestion of any apparatus for ranking trade secrets.

Since the combination of Donner and Eder is not inherently capable of aggregating user judgments related to trade secrets or ranking potential trade secrets, the combination fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

8. Claims 119, 120, 122 and 123 have been rejected as being obvious over Spencer in view of Barney. The Examiner cites in re Gulack and in re Lowry as a basis for rejecting the claims. Both cases are based on In re Miller, in which a measuring cup

differing only in the printed legends was judged by the board to differ from the prior art, overturning examiner's judgment that the legends were merely descriptive. So here, examiner's judgment that a questionnaire (based upon the six factors of a trade secret from the Restatement (First) of Torts) is merely descriptive is in error. The basis of the questionnaire is functionally and structurally interrelated to the useful function of providing a ranked listing of trade secrets and so cannot be seen to be merely descriptive.

In all three cases, Gulack, Lowry, and Miller, the examiner's rejection was overturned because the examiner disregarded claim language that was functionally interrelated to the useful function. So here, examiner has improperly ignored claim language functionally interrelated to the useful function of the invention.

For any of the above reasons, the combination of Spencer and Barney do not teach or suggest "ranking the potential trade secrets", "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value", "ranking the plurality trade secrets" or "comparing the calculate metric to a threshold value".

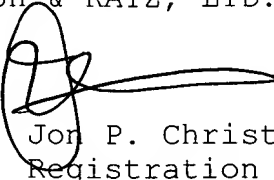
Since the combination of Spencer and Barney does not teach or suggest at least these claim limitations, the combination fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

9. The allowance of claims 1-70 and 119, 120, 121, 122 and 123 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the

subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,
WELSH & KATZ, LTD.

By

A handwritten signature in dark ink, appearing to be "Jon P. Christensen", written over a circular stamp or seal.

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